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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,570	12/14/2001	Merlin E. Scharfe	D/97244	5988

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EXAMINER
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NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/014,570

Applicant(s)

SCHARFE ET AL.

Examiner

Janis L. Dot

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 27 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached, paragraph 1. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☒ Newly proposed or amended claim(s) 6-9, 12-18, 20, 21, 23-26 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 10.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,2,4-9,11-26,28 and 29.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached, paragraph 2.

12. ☐ Not the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

*Janis L. Dot*  
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PRIMARY EXAMINER  
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1. The proposed amendments to claims 4 and 5, filed on Dec. 27, 2004, after the final rejection, changing the dependency of those claims from claim 1 to claim 10, raise rejections under 35 U.S.C. 112, second paragraph, for lack of antecedent basis in claim 10 for "the charge injecting surface" recited in instant claims 4 and 5. Unlike claim 1, claim 10 does not recite the presence of a charge injecting surface.

The proposed amendment to claim 22, filed on Dec. 27, 2004, after the final rejection, changing the dependency of claim 22 from claim 1 to claim 10, raises the issue of new matter and a rejection under 35 U.S.C. 112, first paragraph, for lack of written description. Applicants have not indicated where the originally filed specification describes a hole blocking layer as recited in amended claim 22, that comprises the "crosslinked polysiloxane polymer network impregnated with a hydroxy-functionalized polymer and photogenerating pigments" recited in instant claim 10 and that comprises "polyvinylbutyral, organosilanes, epoxy resins, polyesters, polyamines, polyurethanes, silicones, or polysiloxane" as recited in instant claim 22.

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2. The examiner's refusal to enter the amendment filed after the final rejection on Dec. 27, 2004, renders applicants' arguments regarding the amendment moot.

The objection to the specification, set forth in the final rejection mailed on Oct. 25, 2004, paragraph 5, item (2), stands for the reasons of record. Applicants' comments about enablement do not address the objection. The objection is that the description of making the hole blocking layer in the example is incomplete. The example does not explain how the polymer of Formula III is obtained by merely using a solution of 3-aminopropyl-trimethoxysilane.

The rejections of claims 1, 2, 4-5, 7-9, 22-24, and 26 over Hendrickson combined with (1) Knauf, (2) Grant & Hackh's Chemical Dictionary, pages 293, 503, and 531, (3) Borsenberger, and (4) Ong'877, alone or combined with other cited reference, set forth in the final rejection mailed on Oct. 25, 2004, paragraphs 15 and 16, stand for the reasons of record.

Applicants assert that the Hendrickson teaches only one layer, a topcoat layer comprised of a silicone polymer, and "does not teach two separate and distinct layers as the claims require." However, the instant claims do not recite that the imaging member comprises a separate "cross-linked silicone rubber layer" and a separate "resilient, electrically insulating

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overcoating layer." Rather, instant claims 1 and 2 recite an "imaging member comprising . . . a cross-linked silicone rubber, and a resilient, electrically insulating overcoating layer."

Instant claims 1 and 2 do not limit the location of the cross-linked silicone rubber. Nor do the instant claims exclude the cross-linked silicone rubber from being a component of the overcoating layer. The originally filed specification at page 6, lines 22-24, discloses that the "cross-linked silicone can be an overcoating layer, substantially transparent to activating radiation, electrically insulating . . . ." Applicants cannot argue patentability based on limitations that are not present in the claims. For the reasons discussed in the rejection in paragraph 15, pages 16-18, Hendrickson teaches a topcoat layer comprising a cross-linked silicone rubber that appears to have the properties of the overcoat layer recited in instant claims 1, 2, and 26. Accordingly, for the reasons discussed in the rejection, the Hendrickson cross-linked silicone rubber topcoat layer meets the limitations of the cross-linked silicone rubber and the overcoating layer recited in the instant claims.

The following rejections stand for the reasons of record:

claims 1, 2, 4-9, 11-16, 20-24, 26, 28, and 29 over Ong'737 combined with (1) Borsenberger, (2) Brown, (3) Hendrickson,

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(4) Knauf, and (5) Grant & Hackh's Chemical Dictionary, pages 293, 503, and 531, alone or combined with the other cited reference, set forth in the final rejection mailed on Oct. 25, 2004, paragraphs 18 and 19;

claims 1, 2, 4-9, 12-16, 20-24, and 26 over Ong'877 combined with (1) Borsenberger, (2) Brown, (3) Hendrickson, (4) Knauf, and (5) Grant & Hackh's Chemical Dictionary, pages 293, 503, and 531, alone or combined with the other cited reference, set forth in the final rejection mailed on Oct. 25, 2004, paragraphs 21 and 22; and

claims 1, 2, 4-9, 12-19, 21-24, and 26 over Pai combined with (1) Borsenberger, (2) Brown, (3) Hendrickson, (4) Knauf, and (5) Grant & Hackh's Chemical Dictionary, pages 293, 503, and 531, alone or combined with the other cited references, set forth in the final rejection mailed on Oct. 25, 2004, paragraphs 24-26.

Applicants again assert that the Hendrickson teaches only one layer, a topcoat layer comprised of a silicone polymer, and "does not teach two separate and distinct layers as the claims require." Applicants also assert that Brown teaches away from the instant claims because Brown states that its barrier layer lays between the photoconductive layer and the release layer and that the barrier layer should not be a silicone layer.

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Applicants assert that the instant claims require that Brown's barrier layer be a cross-linked silicone rubber.

However, Brown does not teach away from the claimed invention. As discussed supra, the instant claims do not recite that the imaging member comprises a separate "cross-linked silicone rubber layer" and a separate "resilient, electrically insulating overcoating layer." Applicants cannot argue patentability based on limitations that are not present in the claims. The instant claims do not exclude the cross-linked silicone rubber from being a component of the overcoating layer. The originally filed specification at page 6, lines 22-24, discloses that the "cross-linked silicone can be an overcoating layer, substantially transparent to activating radiation, electrically insulating . . . ." As discussed in the rejections in paragraph 18, pages 27-29, paragraph 21, page 37, and paragraph 24, page 45, Brown teaches a bilayer topcoat comprising a polymeric barrier layer and a cross-linked silicone rubber release layer. The instant claims do not exclude Brown's barrier layer. For the reasons discussed in the rejections, the Brown cross-linked silicone rubber layer appears to have the properties of the overcoating layer recited in instant claims 1, 2, and 26. Accordingly, for the reasons discussed in the rejections, the Brown cross-linked silicone rubber release



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layer meets the limitations of the cross-linked silicone rubber and the overcoating layer recited in the instant claims.

The rejections of claims 1, 2, 6-9, 12-18, 21-23, 25, and 26 over Pai combined with (1) Borsenberger, (2) Kondo, and (3) Grant & Hackh's Chemical Dictionary, page 503, set forth in the final rejection mailed on Oct. 25, 2004, paragraph 28, stand for the reasons of record. Applicants mere traversal of the rejection without any arguments is no reason to withdrawn the rejection.